

DOCKET NO.: 249091US8X

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

REPLY APPLICATION OF:

Kiyotaka OTSUJI, et al.

SERIAL NO: 10/780,566

GROUP: 2625

FILED: February 19, 2004

EXAMINER:

FOR: INFORMATION MANAGEMENT APPARATUS, INFORMATION OUTPUT
SYSTEM, PORTABLE TERMINAL, AND INFORMATION OUTPUTTING
METHOD

LETTER


Mail Stop DD
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith is a European Office Action for the Examiner's consideration. The reference(s) cited therein have been previously filed with the European Search Report in an Information Disclosure Statement submitted to the U.S. Patent and Trademark Office on March 23, 2006.

Respectfully Submitted,

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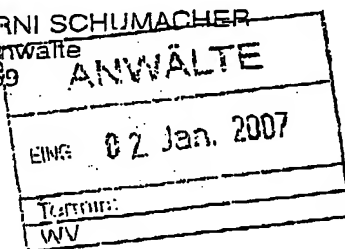
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Application No. 04 004 089.1 - 2211	Ref. 01599	Date 29.12.2006
Applicant NTT DoCoMo, Inc.		

Communication pursuant to Article 96(2) EPC

The examination of the above-identified application has revealed that it does not meet the requirements of the European Patent Convention for the reasons enclosed herewith. If the deficiencies indicated are not rectified the application may be refused pursuant to Article 97(1) EPC.

You are invited to file your observations and insofar as the deficiencies are such as to be rectifiable, to correct the indicated deficiencies within a period

of 4 months

from the notification of this communication, this period being computed in accordance with Rules 78(2) and 83(2) and (4) EPC.

One set of amendments to the description, claims and drawings is to be filed within the said period on separate sheets (Rule 36(1) EPC).

Failure to comply with this invitation in due time will result in the application being deemed to be withdrawn (Article 96(3) EPC).



Noll, Joachim
 Primary Examiner
 for the Examining Division

Enclosure(s): 6 page/s reasons (Form 2906)



Beschheid/Protokoll (Anlage)

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The examination is being carried out on the following application documents:

Description, Pages

1-28

as originally filed

Claims, Numbers

1-5

received on

02.10.2006

with letter of

28.09.2006

Drawings, Sheets

1/7-7/7

as originally filed

1 References

In this communication reference is made to the following official communications, letters of response and documents

1.1 Official communications

C1: Official communications dated 17.05.2006

1.2 Letter of response

L1: Letter of response dated 28.09.2006

1.3 Documents

Filed Date
03/23/2006

D1: WO 01/42894 A (AXIS AB; LARSSON, OLOF; FAGERBERG, LENNART) 14 June 2001 (2001-06-14)

D2: US 2002/054328 A1 (KONISHI MASAHIRO) 9 May 2002 (2002-05-09)

2 Summary

2.1 Independent claims 1, 3-4 are not clear in the sense of Article 84 EPC (see point 3 below).



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2.2 Independent claims 1, 3-4 are not inventive in the sense of Article 56 EPC (see points 4-5 below).

However if amended as suggested in point 4.6 below then **such an amended claim might be novel in the sense of Article 54 EPC and inventive in the sense of Article 56 EPC.**

3 Clarity and conciseness of the claims

3.1 All clarity objections raised in point 3 of communication C1 are maintained because they apply unchanged to independent claims 1 and 3-4.

In particular, the feature (F3) "portable terminal of an output apparatus" is not disclosed anywhere in the further claims or the description and hence does not meet the requirements of Article 83 EPC.

3.2 Despite the reasoning provided by the applicant in his letter L1, **independent claim 3 and 4 do not meet the requirements of Rule 29(2) EPC** because they only differ by the first and second converting step which only convert between "output device identification information" and the "output device global identification information". Therefore, they do not specify interrelated products but merely different embodiments which should be specified as dependent claims.

3.3 **Claims 1 and 4** do not meet the requirements of Article 84 EPC in that the difference between the features "identification information" and "global identification information" can not be established in terms of its technical features.

3.4 According to the requirements of **Rule 32(2)(i) EPC** the same feature shall be denoted by the same reference sign throughout the application. This requirement is not met by claim 1 because the same reference sign "30d" denotes both the "information storage means" and the "inquiry signal transmission means".

4 Inventive step of independent claim 1

4.1 As far as this claim could be understood despite the clarity objections raised in points



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3.1-3.3 above, document D1 is regarded as being the **closest prior art** to the subject-matter of the claim. It discloses already, in correspondence with claim 1 (the references between brackets relate to D1; the original wording of the claim is set in italic font; claimed features which differ from D1 are set underlined):

An information management apparatus (page 13, line 7-15 and figure 1(200)) comprising:

- (F1) *information storage means for storing information relevant to an output apparatus for outputting information, with the stored information linked to global identification information tagged uniformly to the output apparatus and different kinds of goods;*
The database of D1 stores both the documents to be retrieved (page 16, line 18-24 and figure 5(230)) and identification information of the output device (page 19, line 2-24).
- (F2) *output request receiving means for receiving an output request of information (page 16, line 5-7 and figure 5(212)) transmitted from a portable terminal (page 13, line 29 - page 14, line 4);*
- (F3) *inquiry signal transmission means for transmitting an inquiry signal for inquiring said portable terminal of an output apparatus for an output destination (page 23, line 3-8 and figure 11, step 926), when an output request is received by said output request receiving means;*
As far as this feature could be understood despite the objections raised in points 3.1 above, D1 discloses identifying an output device (page 19, line 2-24) in the vicinity of the user's current position (page 21, line 1-11).
- (F4) *image data receiving means for receiving image data transmitted from said portable terminal (page 16, line 13-17 together with page 16, line 34-35 and figure 5(216));*
- (F5) *identification information acquisition means (page 17, line 11-21 and figure 5(218)) for analyzing image data transmitted from said portable terminal (page 16, line 30-35) in response to said inquiry signal (page 23, line 3-8 and figure 11, step 926) and received by said image data receiving means, and for ~~acquiring identification information relevant to an output apparatus involved in said image data;~~*
- (F6) *converting means for converting identification information of the output*



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- apparatus acquired by said identification information acquisition means into global identification information (page 23, line 17-19 and figure 11, step 934);*
- (F7) *information retrieval means for retrieving information relevant to said output apparatus (page 23, line 17-19 and figure 11, step 934) from said information storage means (page 16, line 18-27 and figure 5(230)) based upon the global identification information converted by said converting means (page 23, line 17-19 and figure 11, step 934);*
- (F8) *and information output means for, based upon the information relevant to the particular output apparatus retrieved by said output destination information retrieval means, outputting the information to said particular output apparatus (page 23, line 19-35 and figure 11, steps 936-940).*

- 4.2 Thus, the subject-matter of claim 1 differs from D1 in that in claim 1, the identification information of the output device is extracted from the captured image whereas in D1 it is retrieved from a database.
- 4.3 The **objective technical problem** to be solved by the above difference is to provide an alternative output device identification.
- 4.4 Since the output device of D1 are identified automatically (D1, page 20, line 25-29) and they send their configuration information without additional user interaction (D1, page 23, line 15-23 and figure 11, steps 932 and 934), the apparatus both of this claim and D1 identifies the output devices automatically. Document D2 which also relates to identifying objects for printing object information (D2, paragraphs 10-11) discloses that identification information is extracted from captured images (paragraphs 42-43). Applying the extraction of identification information of D2 to the output device selection of D1 directly leads to the subject matter of this claim.
- 4.5 Therefore, the subject-matter of claim 1 is **not inventive** und thus not allowable in the sense of Articles 52(1) and 56 EPC.
- 4.6 However, **if this claim was amended** to overcome the objections raised in point 3 above and to specify in the characterizing part of the claim how the identification



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number of an output device is extracted from the image of the output device and that both images are transferred together as defined in claims 3 or 5 then **such an amended claim might be novel in the sense of Article 54 EPC and inventive in the sense of Article 56 EPC.**

5. Inventive step of independent claims 3 and 4

All objections, conclusions and suggestions for **apparatus claim 1** apply accordingly to **independent method claim 3** which only contains method steps corresponding to the features of **claim 1**.

6. Inventive step of dependent claims 2 and 5

All objections, conclusions and suggestions for **apparatus claim 1** apply accordingly to these claims.

7. The applicant should also note the following:

7.1 In the further prosecution of the application, failure to file an amended set of claims which complies with Rule 29(2) EPC, or to submit convincing arguments as to why the current set of claims does in fact comply with these provisions, **may lead to refusal of the application under Article 97(1) EPC.**

7.2 Independent claims 1 and 3 are not in the two-part form in accordance with Rule 29(1) EPC, which in the present case would be appropriate, with those features F1-F4 and F6-F8 known in combination from the prior art (document D1) being placed in the preamble (Rule 29(1)(a) EPC) and with the remaining features F6 being included in the characterising part (Rule 29(1)(b) EPC). Independent claims 1 and 3 should therefore be redrafted accordingly.

7.3 Claims 1 and 3 should be redrafted to overcome the objections raised in point 3 above.

7.4 When filing amended claims the applicant should at the same time bring the



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description into conformity with the amended claims. Care should be taken during revision, especially of the introductory portion and any statements of problem or advantage, **not to add subject-matter which extends beyond the content of the application as originally filed (Article 123(2) EPC).**

- 7.5 To meet the requirements of Rule 27(1)(b) EPC, the **documents D1-D2 should be identified in the description** and their relevant contents should be indicated. The applicant should ensure that it is **clear from the description which features of the subject-matter of independent claims 1 and 3 are known from the document D1-D2.**
- 7.6 The vague and imprecise statements in the description (paragraph 70 and 80) implies that the subject-matter for which protection is sought may be different to that defined by the claims, thereby resulting in lack of clarity of the claims (Article 84 EPC) when used to interpret them (see the Guidelines, C-III, 4.3a). These statements should therefore be amended to remove this inconsistency.
- 7.7 In the further procedure, **Article 123(1) EPC and Rule 86(3) EPC will be strictly applied:** the next submission is the last possibility for the applicant to overcome the objections above.
Admissibility of further new sets of claims under Rule 86(3) EPC will be subject to the compliance, "prima facie", to Rule 29(2) EPC (see point 3.2 above), Rule 29(5) EPC, to Article 123(2) EPC, Article 84 EPC (see point 3 above) and finally to Rules 29(1)/27(1)(b) EPC (see points 6.2 and 6.5 above).
- 7.8 **Any changes made when amending the claims, the description or the drawing should be clearly identified and marked as changed and/or amended.**